



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,642	01/22/2004	David Howell	2103042-991100	2449

26379 7590 03/09/2006

DLA PIPER RUDNICK GRAY CARY US, LLP
2000 UNIVERSITY AVENUE
E. PALO ALTO, CA 94303-2248

EXAMINER

BLACKWELL, JAMES H

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/763,642	Applicant(s) HOWELL, DAVID	
	Examiner James H. Blackwell	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to an original application filed 01/22/2004 with a priority date of **01/22/2004**.
2. Claims 1-36 are pending. Claims 1, 13, and 25 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine (U.S. Patent Application Publication 2004/0205462 filed 01/07/2002, published 10/14/2004).

In regard to independent Claim 1 (and similarly independent Claims 13, and 25), Levine teaches a workflow and system for print-on-demand book reproduction starting with the input (*input module*) of both digital and hard-copy electronic versions of a work, which are then converted (*converts the input file into an intermediate format file*) to a solution-independent, intermediate format set of files that are then stored with attached metadata (title, author, publisher, ISBN, and publication date) (*a storage device comprising a storage portion that stores the intermediate format file and a storage portion into which a piece of work metadata associated with the input file is stored*).

Levine also teaches *a conversion module that generates one or more editions of a work having one or more formats, the one or more editions of the work being generated based on the intermediate format file and the work metadata* in that once a request is made for a book, the stored, solution-independent, intermediate format files are converted depending on whether a bound book or an electronic book is requested (see Figs. 2, 3; workflow paths for bound and e-book).

Levine does not explicitly teach *a module that validates the input file*. However, it would have been obvious to one of ordinary skill in the art at the time of invention for some sort of validation to have occurred by virtue of transfer protocols (http, ftp) that perform checks to make certain that data transfer was complete and successful and that were available at the time of invention.

In regard to dependent Claim 2 (and similarly independent Claims 14, and 26), Levine teaches *a storage portion that stores a piece of form metadata associated with the intermediate format file, the form metadata specifying a form of an edition of the work* (Fig. 2, steps 204, 206 acquire or generate book production information both from the intermediate form of the files and also acquire or generate book production information, including printing and binding information; acquired information is stored in memory).

In regard to dependent Claim 3 (and similarly independent Claims 15, and 27), Levine teaches *a distribution module that distributes the one or more editions of the work* as it allows for the distribution of both hard-copy and electronic versions of a given publication (Figs. 1-3).

In regard to dependent Claim 4 (and similarly independent Claims 16, and 28), Levine teaches a plurality of distribution channels, wherein each distribution channel receives a different edition of the work (Figs. 2, 3 depict creation of an e-book or a hardcopy and different distribution methods for each).

5. Claims 5, 8-10, 17, 20-22, 29, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view of Daniel et al. (hereinafter Daniel, U.S. Patent Application Publication 2003/0163784 filed 12/12/2002, published 08/28/2003).

In regard to dependent Claim 5 (and similarly independent Claims 17, and 29), Levine fails to explicitly teach that the distribution module further comprises a web site into which the one or more editions of the work are loaded wherein the one or more editions of the work are available for download from the web site. However, Daniel teaches using the web as a distribution mechanism for instructional or informational content to end-users (Abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Levine and Daniel as both inventions relate to the collection, generation, and distribution of reading materials. Adding the teaching of Daniel provides the benefit of a well known, and heavily used electronic distribution method for the distribution of publications.

In regard to dependent Claims 8-9 (and similarly independent Claims 20-21, and 32-33), Levine fails to teach a template storage device that stores one or more templates that transform the intermediate format file into an edition of the work. However, Daniel discusses that items uploaded for compilation into publications

Art Unit: 2176

(teaching materials) are stored in XML and are transformed (styled) using a selection of skins (templates, style sheets) (Pg. 3, Paragraph [0025]; Pg. 12, Paragraphs [0107-0108]). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Levine and Daniel as both inventions relate to the collection, generation, and distribution of reading materials. Adding the teaching of Daniel provides the benefit of using templates to give the publication a specific and uniform look-and-feel.

It is noted that neither Levine nor Daniel specifically state the use of XSL-FO to style their documents, it would have been obvious to one of ordinary skill at the time of invention to have used XSL-FO as it represented a more advanced and particularly XML format friendly tool to use for style sheet purposes.

In regard to dependent Claim 10 (and similarly independent Claims 22, and 34), Levine fails to teach *an edition containing a subset of the work metadata associated with the intermediate format file*. However, Daniel teaches that after all necessary e-content or e-learning objects are created, the author or course instructor then arranges a selected subset of the e-content or e-learning objects, representing topics and sub-topics, into a particular sequence to produce one or more larger publication or instruction objects that cover sections (i.e., module objects) into a particular sequence to define an electronic publication or CAI course. In this manner, the author, publisher or course instructor is able to assemble his or her publication or course from a plan in a modular manner, wherein each constituent object can be modified or removed, or new objects added, independently without changing content

Art Unit: 2176

pertaining to the rest of the publication or course (Pg. 3, Paragraph [0025]). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Levine and Daniel as both inventions relate to the collection, generation, and distribution of reading materials. Adding the teaching of Daniel provides the benefit of using only portions of stored materials to create documents, which are associated with metadata as taught by Levine.

6. Claims 6-7, 18-19, and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view of McCurdy et al. (hereinafter McCurdy, U.S. Patent Application Publication 2002/0035697 filed 07/02/2001, published 03/21/2002).

In regard to dependent Claims 6-7 (and similarly independent Claims 18-19, and 30-31), Levine fails to teach that *the distribution module distributes the one or more editions of the work to a wireless device*. However, McCurdy suggests using devices for reading magazines that make requests and receive reading materials wirelessly and also teaches the future use of Bluetooth as one possible wireless protocol for transferring reading material (Pg. 25, Paragraph [0386]). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Levine and McCurdy as both inventions relate to the collection, generation, and distribution of reading materials. Adding the teaching of McCurdy provides the benefit of a well-known and heavily used wireless electronic distribution method for the distribution of publications.

7. Claims 11-12, 23-24, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view of Barsness et al. (hereinafter Barsness, U.S. Patent Application Publication 2004/0201633 filed 09/13/2001, published 10/14/2004).

In regard to dependent Claims 11-12 (and similarly independent Claims 23-24, and 35-36), Levine fails to teach that *the feedback for an edition further comprises one or more of a number of copies of an edition sold, a sales price of an edition, a geographic distribution of the edition and demographics of final users of the edition.* However, Barsness teaches that, where the content is being created by an instructor, or any other author for that matter, the usage statistics may be utilized in revising the content, e.g., to simplify certain passages, make certain passages more understandable, etc., as shown in block 212. Once the content is revised, the content may optionally be redistributed to users as shown by the arrow from block 212 to block 204. The usage statistics in this application are therefore utilized to assist an author in improving the quality of authored content based upon the *usage statistic feedback generated by one or more users* (Pg. 7, Paragraph [0085]). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Levine and Barsness as both inventions relate to the collection, generation, and distribution of reading materials. Adding the teaching of Barsness provides the benefit of providing feedback to authors and publishers about their products' usage.

Art Unit: 2176

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
03/01/2006

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER

3/5/2006